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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER	
GARG, YOGESH C	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/932,638
Filing Date: August 16, 2001
Appellant(s): PHILLIPS, QUINTIN T.

James D. Shaurette
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/9/2006 appealing from the Office action (Final rejection) mailed 8/24/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Rejection of claim 27 under 35 USC, First paragraph is withdrawn in view of the applicant's representative Mr. Shaurette providing support for the limitations recited in claim 27, see Telephone Interview summary mailed on 2/14/2006.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(A). The 102 rejection of claim 9.

(B). The 102 rejection of claim 17.

(C). The 102 rejection of claims 10 and 18.

(D). The 102 rejection of claims 16 and 23.

(E). The 102 rejection of claim 23.

(F). The 103 rejection of claims 25-26 and 30.

(G). The 103 rejection of claim 27.

A copy of Final rejection mailed on 8/24/2005 is reproduced below:

Quote: "

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application

filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9-24 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated Sekizawa (US Patent 6,430,711 B1).

Note: Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Regarding claims 9 and 17, Sekizawa discloses a marketing method comprising:

accessing a condition associated with an operation of an image forming device configured to use a consumable to form a hard image; monitoring the operation of the image forming device; communicating a request externally of the image forming device using the image forming device and responsive to the monitoring; receiving a message responsive to the communicating the request; and communicating the message using the image forming device (see at least col.18, line 45-col.19, line 44 and Fig.1 which reads on the recited limitations of claim 1. The monitor system of Fig.1 displays printers (p1....pn), which correspond to an image forming device using consumables, and further include agent units "10" which monitor the printer's operation. The agent unit accesses and monitors the operating conditions and status of the consumables (see col.19, lines 21-35), communicates a request and a message externally to unit "20", which receives the message. Unit 20 corresponds a unit of marketing system as it organizes delivery schedules of consumables (see at least col.19, lines 36-42). Note: A request is an act of asking or sending a message for something to be done or given. The status information sent by agent unit 10 includes message about the abnormal state of the machine (see at least col.5, lines 32-50) which requires maintenance ending up in providing services and dispatching maintenance personnel. Sekizawa teaches that the integrated monitor unit "20" installed in an agency selling printers (col.19, lines 6-14) communicates to the printer user a warning message about the abnormal state of the printer (see at least col.5, lines 32-50).

Regarding claims 10 and 18, Sekizawa discloses that in the method of claim 9 the accessing comprises accessing the condition from the consumable (see col.19, lines 21-35). Sekizawa discloses accessing a condition associated with an operation of the image forming device from the consumable ,

see at least col.9, lines 12-40, " *The integrated monitor unit thus configured periodically gets and retains the status information containing remaining amount information of a consumable article of the machine to be monitored such as a printer (for example, ink, toner, or an ink ribbon) and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information*..... ", and col.16, line 64-col.17, line 9, which discloses receiving status information via a computer of a printing machine as regards to a balance amount of different consumables, such as ink, toner, ink-ribbon left in the machine. Accessing condition of different variables, that is status information separately from different consumables, such as ink, toner, ink-ribbon corresponds to accessing a condition associated with an operation of the image forming device from the consumable.

Regarding claims 11 and 19, Sekizawa discloses that the accessing comprises accessing the condition related to a status of the consumable and the monitoring comprises monitoring the status of the consumable (see col.19, lines 21-35, Note: Sekizawa discloses accessing the condition related to consumables, such as, toner and ink and then monitoring the quantity of toner or ink.). Also refer to at least col.9, lines 12-40, " *The integrated monitor unit thus configured periodically gets and retains the status information containing remaining amount information of a consumable article of the machine to be monitored such as a printer (for example, ink, toner, or an ink ribbon) and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information*..... ",and col.16, line 64-col.17, line 9 which disclose monitoring and accessing the condition related to the balance amount of different consumables.

Regarding claims 12 and 20, Sekizawa discloses that the accessing comprises condition not related to a status of the consumable (see at least col.5, lines 32-49 which is related to accessing an abnormal state of machine, that is a mechanical failure requiring maintenance which needs dispatching maintenance personnel to fix the repairs).

Regarding claims 13 and 21, Sekizawa discloses that the accessing comprises accessing the condition related to a life span of the image forming device and the monitoring comprises monitoring the life span of the image forming device (see at least col.1, lines 5-18 and col.2, lines 43-49 which suggest monitoring and accessing the operating conditions of the printers for the life span of the installed machines and managed by an agency who has sold these printers (see col.19, lines 6-14).

Regarding claims 14 and 22, Sekizawa discloses that the accessing comprises accessing the condition related to a status of another consumable not having the condition, and the monitoring comprises monitoring the status of the another consumable (see col.19, lines 19-35 which teaches monitoring a plurality of consumables) and col.9, lines 12-40, " *The integrated monitor unit thus*

configured periodically gets and retains the status information containing remaining amount information of a consumable article of the machine to be monitored such as a printer ***(for example, ink, toner, or an ink ribbon)*** *and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information.....* ".

Regarding claims 15, Sekizawa that the accessing comprises accessing a plurality of conditions related to statuses of a plurality of consumables used by the image forming device to form the hard image, and the monitoring comprises monitoring the statuses of the consumables (see col.19, lines 19-35 which teaches monitoring a plurality of consumables) and col.9, lines 12-40, " *The integrated monitor unit thus configured periodically gets and retains the status information containing remaining amount information of a consumable article of the machine to be monitored such as a printer* ***(for example, ink, toner, or an ink ribbon)*** *and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information.....* ".

Regarding claims 16 and 23, Sekizawa discloses that the communicating the request comprises communicating the request including an identifier of the image forming device (see at least Fig.17 and col.20-line 55-col.21, line 20 which discloses when sending requests/messages include identifiers, such as the printer's name, serial number and IP address), and further comprising selecting the message from a plurality of other messages using the identifier, and wherein the communicating the message comprises communicating the message after the selecting (see col.19, lines 15-35 which teaches console unit 20 receiving a plurality of messages from a number of printers and as analyzed above each message from a particular printer includes the identification details which will be required to enable the console unit 20 to select messages when sending consumables for replenishment or deputing maintenance personnel to fix mechanical repairs to a particular machine). Note: Status information 01, which includes the request message as analyzed above, does include the printer registration log file and further see at least col.35, lines 16-27 which teaches selecting an unread message from a plurality of messages based upon the identity of the printer.

Regarding claims 24 and 29, Sekizawa discloses monitoring the operation of the image forming device with respect to the condition, see col.5, lines 32-50, which disclose the monitoring the operation of the printer for an extended period of time with respect to particular condition, that is if it is a paper jam and is corrected subsequently but if it is an abnormal condition, such as mechanical failure which is not corrected then alerts the user of the printer and dispatches maintenance personnel.

Regarding claim 28, Sekizawa suggest that communicating the message comprises displaying the message using a display of the image forming device, see at least col.20, lines 36-46 which disclose that the status information to be sent to integrated monitor, " 20", can be displayed on the screen of local agent "10", wherein the local agent "10" is part of the image forming device, that is printer.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.1. Claims 25-26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekizawa in view of Hayward et al. (US Patent 6,798,997) hereinafter referred to Hayward.

Regarding claims 25 and 30, Sekizawa discloses all the limitations of claims 24 and 29, as analyzed above, but does not explicitly teach communicating the request message in response to monitoring detecting the operation of the image forming device triggering the condition. Hayward, in the same field of endeavor, teaches communicating the request message in response to monitoring detecting the operation of the image forming device triggering the condition , see at least col.2, lines 5-63, which teach that if a consumable reaches a threshold status which requires action to replace that is detecting a threshold condition which triggers of a request for purchase or replenishment of that item in time. In view of Hayward, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Sekizawa to incorporate the feature of sending a request message in response to triggering of a condition of the printer because rather then to wait and read the mails about the status of a condition an automatic communication to the resource for replenishment of a replacement part or consumable item or to send maintenance personnel for an abnormal failure would result in reducing the downtime of the printer.

Regarding claim 26, Sekizawa discloses all the limitations of claim 9, as analyzed above but does not explicitly teach communicating comprises marketing information regarding purchase of an item associated with the formation of hard images. Hayward, in the same field of endeavor, teaches that comprises marketing information regarding purchase of an item associated with the formation of hard images, see at least col.2, lines 5-63, which teach that if a consumable reaches a threshold status which requires action to replace that is detecting a threshold condition which triggers of a request for purchase

or replenishment of that item in time. In view of Hayward, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Sekizawa to incorporate the feature that communicating comprises marketing information regarding purchase of an item associated with the formation of hard images because rather then to wait and read the mails about the status of a condition an automatic communication to the resource for purchase of a part or consumable item would result in reducing the downtime of the printer.

6.2. Claim 27 is rejected under 35 U.S.C. 103(a) as being obvious over Sekizawa in view of Official Notice.

Regarding claim 27, Sekizawa discloses all the limitations of claim 9, as analyzed above but does not explicitly teach that communicating the message comprises printing the message upon paper. The examiner takes Official Notice of the well-known fact of printing electronic messages on paper, that is the fact of printing e-mails or other electronic messages on paper is well-known so that the stored message on paper can be stored at convenience and read or referred to later. In view of the Official Notice, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to incorporate the feature of printing the message upon a paper for the obvious well-known reason of storing message on paper and then referring to it or reading it at a later time as per the user's convenience. "

Unquote:

(10) Response to Argument

(A). The 102 rejection of claim 9.

The applicant argues that the cited reference Sekizawa does not disclose the limitation, " communicating a request externally of the image forming device using the image forming device" (see AB, pages 3-4). The examiner respectfully disagrees. In the Final office action mailed on 8/24/2005, see page 7, the examiner considered the installation at 2a, 2b or 2c equivalent to an image forming device/system as claimed, "

The monitor system of Fig.1 displays printers (p1....pn), which correspond to an image forming device using consumables, and further include agent units "10" which monitor the printer's operation.

", that is the establishments, such as 2a, 2b and 2c have an image forming device/system comprising components agent unit 10 integrated with a component printer p via a router 4 which correspond to the claimed image forming device in the instant application. The component agent unit 10, router 4 and the printer are components of the image forming device/system located in an establishment and this image forming device/system in Sekizawa communicate with external systems, such as console 20 installed in a marketing department of a manufacturer for selling printers and parts/consumables and providing services required for printers, via Internet. The console unit 20 corresponds to an external source as claimed in claim 9 and in other claims as well. The image forming device/system installed in 2a, 2b and 2c sends messages to console 20 and as well as receives messages from console 20 via Internet. Monitoring of the image forming device/system installed in 2a, 2b and 2c is done internally by the component agent 10, also described as a local monitor unit getting the status information of the printer and consumables and transmitting this status information to console unit 20 also described as an integrated monitor unit installed remotely from the local monitor unit (see at least col.2, line 63-col.3, line 59). Console unit 20 sends messages relating the delivery schedules of consumables, printer check sheets, etc. to the image forming device/system installed in 2a, 2b and 2c via the component agent unit 10.The function of the component agent unit 10 is also A request is an act of asking or sending a message for something to be done or given. The status information, including status on consumables such as, toner, ink, etc. (see at

least col.19, lines 15-42) and a message about the abnormal state of the machine (see at least col.5, lines 32-50) are sent by the component agent unit 10, based upon its monitoring the operation of the printer, to console 20 ending up in providing services and dispatching maintenance personnel to the image forming device/system installed in 2a, 2b and 2c. Therefore, it is quite obvious to the examiner that Sekizawa anticipates the recited limitation in claim 9, " communicating a request externally of the image forming device using the image forming device and responsive to the monitoring".

The applicant further argues (see AB, page 4, last paragraph-page 5) that Sekizawa does not teach the limitation, "receiving a message responsive to communicating the request". The examiner respectfully disagrees. It is already analyzed above that the component agent unit 10 of the image forming device/system installed at a particular business installation, also described as a local monitoring unit, sends status information on the printer/machine component of the image forming device/system to console 20, that is the remotely installed integrated monitor unit in a marketing department of a manufacturer for selling printers and parts/consumables and providing services required for printers, via Internet. Sekizawa explicitly teaches that the integrated monitor unit "20" installed in an agency selling printers (col.19, lines 6-14) communicates to the printer/machine user a warning message about the abnormal state of the printer and dispatching maintenance personnel, see at least col.5, lines 14-50, in response to the status message, which as analyzed above corresponds to a request, received from the component agent unit 10 of the image forming device/system. In view

of the foregoing, it is obvious to the examiner that Sekizawa discloses , "receiving a message responsive to communicating the request".

The applicant also argues that Sekizawa does not suggest the limitation, " communicating the message using the image forming device. The examiner does not agree because, as analyzed above, the message received from the console 20 in response to the status information received from the local monitor [component agent unit 10 of the image forming device/system], is communicated to the printer user in the form of a warning message about the abnormal state of the printer and dispatching maintenance personnel (see at least col.5, lines 14-50).

(B). The 102 rejection of claim 17.

The applicant argues (see AB pages 5-6) that Sekizawa does not teach the limitation, " communicating a request using the image forming device to a marketing system". The examiner respectfully disagrees for reasons as analyzed above for the similar limitation of claim 9. Console 20 in Sekizawa represents the terminal of an external marketing system and is housed in the marketing department of a manufacturer for selling printers and parts/consumables and providing services required for printers, via Internet.

The applicant argues (see AB page 6) that Sekizawa does not teach the limitation, " communicating a message using the marketing system responsive to receiving the request". The examiner disagrees for reasons as analyzed above for claim

9 wherein it was shown that console 20 which corresponds to the terminal of a marketing system communicates message using console 20, relating to delivery of consumables, such as toner, ink, etc in response to receiving status information from the image forming device/system and also warning signals about the abnormal state of printer and dispatching maintenance personnel in response to receiving status information of the image forming device/system from the image forming device/system

The applicant further argues (see AB page 7) that Sekizawa does not suggest the limitation, " communicating the message using the image forming device. The examiner does not agree because, as analyzed above, the message communicated by the console 20, which corresponds to the terminal of a marketing system, in response to the status information received from the local monitor [component agent unit 10 of the image forming device/system], is communicated to the printer user in the form of a warning message about the abnormal state of the printer and dispatching maintenance personnel (see at least col.5, lines 14-50).

(C). The 102 rejection of claims 10 and 18.

The applicant argues (see AB pages 7-8) that Sekizawa does not teach or suggest the limitation that is " accessing comprises accessing the condition from the consumable" in combination with the limitations of the claim 9 or 17. The examiner respectfully disagrees again. It is already analyzed above that Sekizawa discloses or suggests the limitations of claims 9 and 17. Sekizawa also discloses accessing a condition associated with an operation of the image forming device from the

consumable, see at least col.9, lines 12-40, " *The integrated monitor unit thus configured periodically gets and retains the status information containing remaining amount information of a consumable article of the machine to be monitored such as a printer (for example, ink, toner, or an ink ribbon) and predicts the statistics of the remaining amount of the consumable article based on a plurality of pieces of the retained status information*..... ", and col.16, line 64-col.17, line 9, which discloses receiving status information via a computer of a printing machine as regards to a balance amount of different consumables, such as ink, toner, ink-ribbon left in the machine. Accessing condition of different variables, that is status information separately from different consumables, such as ink, toner, ink-ribbon corresponds to accessing a condition associated with an operation of the image forming device from the consumable. The applicant also argues (see AB page 7, lines 29-30) that Sekizawa does not disclose " how the status information of the consumable is obtained" and "accessing a condition associated with an operation of the image forming device from the consumable". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "how the status information of the consumable is obtained" and "accessing a condition associated with an operation of the image forming device from the consumable") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(D). The 102 rejection of claims 16 and 23.

The applicant argues (see AB pages 8-9) that Sekizawa does not disclose or suggest that the step of communicating a request in claims 9 or 17 comprise an identifier of the image forming device. The examiner respectfully disagrees. It has been analyzed above that the image forming device/system in Sekizawa includes the component agent unit 10 [also known as local monitor unit] and the printers connected to each other by router 4. Sekizawa discloses that the communicating the request comprises communicating the request including an identifier of the image forming device (see at least Fig.17 and col.20-line 55-col.21, line 20 which discloses when sending requests/messages include identifiers, such as the printer's name, serial number and IP address). Since the printer component and the agent unit 10 are components of the image forming device, communicating of identification of the printer component to the console unit 20 refers to communicating the identifier of the image forming device/system as a whole and reads on the recited limitation, that is communicating a request in claims 9 or 17 comprise an identifier of the image forming device.

(E). The 102 rejection of claim 23.

The applicant further argues (see AB pages 9-10) that Sekizawa does not disclose the recited limitation in claim 23, that is "selecting the message from a plurality of other messages using the identifier, and wherein the communicating the message comprises communicating the message after the selecting". In fact, Sekizawa does disclose this limitation, see col.19, lines 15-35. The console unit 20 [the integrated

monitor remotely installed from the image forming device] receives a plurality of messages from a number of image forming devices/systems including printers and component agent units 10 from different installations, such as 2a, 2b, 2c and as analyzed above each message from a particular image forming devices/systems including a printer includes the identification details which will be required to enable the console unit 20 to select messages when sending consumables for replenishment or deputing maintenance personnel to fix mechanical repairs to a particular machine). Note: Status information 01, which includes the request message as analyzed above, does include the image forming devices/system identifier in the form of printer registration log file and further see at least col.35, lines 16-27 which teach selecting an unread message from a plurality of messages based upon the identity of the printer, which is a component of the image forming device/system identifying it.

(F). The 103 rejection of claims 25-26 and 30.

With respect to rejection of claims 25-26 and 30, the applicant argues (see AB pages 11-13) that there is insufficient motivation to combine the teachings of Sekizawa and Hayward references because the Office has failed to present any evidence that by combining the teachings of Hayward would decrease the downtime or would result in any other improvement in the Sekizawa. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation

to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art.** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both the prior arts of Sekizawa and Hayward are directed to the same field of endeavor, that is monitoring the operation of image forming devices including printing operations and on monitoring and detecting the status of the printer component or consumables electronically communicating a message to an outside source for further action to be taken (see Hayward, col.1, line 63-col.2, line 4 and see Sekizawa col.5, lines 14-50 and col.19, lines 15-42). In Sekizawa, the action of dispatching maintenance personnel is taken based upon the message received by the console unit 20 from the local monitoring component agent unit 10. These messages received from the component agent unit 10 are stored and transmitted in batches to the console unit 20 (see Sekizawa at least col.4, lines 44-63 and col.9, lines 11-40). Sekizawa does not explicitly disclose triggering the condition due to an abnormal mechanical failure in the device/system, as recited in claims 25 and 30. However, Hayward teaches communicating the request message in response to monitoring detecting the operation of the image forming device and triggering the condition, see at least col.2, lines 5-63, such that that if a consumable reaches a threshold status which requires action to replace that is detecting a threshold condition which triggers of a request for purchase or replenishment of that item in time. In view of Hayward and at the time of applicant's invention, it would be obvious to one of an ordinary skilled in the art to modify Sekizawa to improve it by combining the known feature of sending a

request message in response to triggering of a condition of the printer, such as abnormal mechanical failure because it would definitely result in a faster action for sending maintenance personnel and parts to repair the machine and reduction of the downtime of the printers as compared to storing the e-mails and transmitting and receiving the status e-mails in batches to be read and acted upon by an operator. Further, this combination is in line with the objective of Sekizawa to reduce the waiting time for the customers for arrival of maintenance personnel and parts (see col.2, lines 6-9).

Similarly, with regards to the limitations of claim 26, Sekizawa discloses all the limitations of claim 9, as analyzed above but does not explicitly teach communicating the message from the console unit 20 comprises marketing information regarding purchase of an item associated with the formation of hard images. Hayward, in the same field of endeavor, teaches that a response message from the console unit 20, which is housed in the marketing department of a manufacturer selling printers, their parts and consumables, comprises marketing information regarding purchase of an item associated with the formation of hard images, see at least col.2, lines 5-63, which teach that if a consumable reaches a threshold status which requires action to replace that is detecting a threshold condition which triggers of a request for purchase or replenishment of that item in time. In view of Hayward, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Sekizawa to incorporate the feature that communicating a message from console unit 20 comprises marketing information regarding purchase of an item associated with the

formation of hard images because rather then to wait and read the mails about the status of a condition an automatic communication to the resource for purchase of a part or consumable item would result in reducing the downtime of the printer.

Following court cases also justify the combination of the teachings of Sekizawa and Hayward with proper motivation as stated above:

In re Fine, 5 USPQ2d 1596 (CA FC 1988)

"The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

In re Bozek, 163 USPQ 545 (CCPA 1969)

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

In re Beattie, 24 USPQ2d 1040 (CA FC 1992)

"Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. "

In this case, at the time of the applicant's invention it would be well within the common knowledge and common sense of one of an ordinary skilled in the art to combine the features/teachings of Hayward, that is initiating a trigger with Sekizawa's teachings resulting in reduced downtime and better customer service by attempting to

reduce the waiting time for the customers for arrival of maintenance personnel and parts in case of abnormal mechanical failure of the machine.

(G). The 103 rejection of claim 27.

The applicant has traversed the examiner's reliance upon Official Notice (see AB pages 13-14) by stating that it is improper and has demanded for a documentary evidence. The applicant added claim 27 as a new claim in his amendment received on 5/6/2005. The limitation, " wherein the communicating the message comprises printing the message upon paper" further narrows down the limitation " communicating the message using the image forming device" recited in independent claim 9 which implies that the received message in response to a request sent by the image forming device is printed by the image forming device. Since it is notoriously well-known in the art at the time of the applicant's invention that image forming devices/systems including facsimiles and network printers are capable of receiving a message and printing the same upon paper, the examiner took an official notice of the concept that communicating the message using the forming device comprises printing the message upon paper. In response, the examiner cites at least the following three evidences [Note: the following references are being provided as evidences only and not as new grounds of rejection] which prove that it would be well within the common knowledge and common sense of one of an ordinary skilled in the art at the time of the applicant's invention to communicate a message to an image forming device, such as a facsimile or a network printer which comprises printing the message upon a paper :

(i) US Patent 6,654,601 to Picoult et al. (see at least col.7, lines 46-57), "*Progressing to step 560, the method continues where mobile device 130 performs document translation from e-mail format to facsimile format, i.e., a TIFF image, in order to successfully transmit the message to facsimile 150. ..... The method proceeds to step 570 where mobile device 130 routes the message using a wireless communication, such as Bluetooth, to the facsimile device 150.* ***At step 580, facsimile 150 receives and prints the message.*** *The method ends at step 590.* ".

(ii) US Patent 6,522,421 to Chapman et al. (see at least Abstract and col.4, lines 23-57, "*.....the method comprising: providing a printing system with an interface to receive an application file containing the document production job, the printing system having the printer operatively coupled to a server, the server being operatively coupled to a raster image processor within the printing system and a device for recognizing E-mail addresses contained within the application file that includes information to be reproduced as the document reproduction job;* ***..... wherein, once the application file is sent to the printing system traverses from the server to the raster image processor no status of the document production job is available to the computational element; ..... sending the application file to the printing system;*** *detecting the E-mail information at the printing system; processing the application file to produce a printed document; .....* ". Note: the application file received including the document to be printed corresponds to a message received by the printer which is printed as a hard copy document.).

(iii) US Patent 5889595 to Kim et al. (see at least col.1, lines 37-58), "*Generally, a facsimile telecommunications system receives image data by executing a system protocol ....Protocol sets rules for the interaction of transmission and reception of units of telecommunications equipment, that are usually implemented through the programming of the data terminal equipment involved rather than being built into the hardware. In a plain paper facsimile system dedicated to printing image data onto cut sheets of a printable medium such as paper, ... After the image data is received, an operation for*

printing the image data is executed. .... ". Note: The facsimile, which is an image forming device receives messages in the form of image data which is printed upon a paper.

The applicant further argues that "there is absolutely no evidence of record of the claimed printing of a message upon paper where the message was received responsive to a request which was communicated externally of the image forming device to monitoring of an operation of the image forming device as explicitly claimed". The examiner respectfully disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the examiner has combined Sekizawa and Official Notice to render the claimed limitations "printing of a message upon paper where the message was received responsive to a request which was communicated externally of the image forming device to monitoring of an operation of the image forming device", as analyzed in the Final action mailed on 8/24/2005 and has not relied on the individual references. The examiner has already analyzed above that Sekizawa suggests/discloses all the limitations of independent claim 9 and has provided evidences for the Official Notice used by the examiner to show obviousness of the fact that received messages by image forming devices/systems, such as facsimiles and net-work printers are printed upon a paper by them. The motivation for combining the Official Notice with Sekizawa teachings would be well within the common knowledge and common sense of one of an ordinary skilled in the art at the time of the applicant's

invention because printing the message upon paper would allow to store the message on paper and then it would be possible to refer to it or read it at a later time as per the user's convenience.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
Yogesh C. Garg
Primary Examiner (AU 3625)

Conferees:

Wynn Coggins
SPE AU 3625

John Weiss
SPE AU 3629

4-13-06